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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,338

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Brian Francis Gray

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08/28/2006

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EXAMINER

GIBSON, KESHIA L

ART UNIT

PAPER NUMBER

3761

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/089,338
Filing Date: January 17, 2003
Appellant(s): GRAY ET AL.

MAILED

AUG 28 2006

Group 3700

Roddy M. Bullock
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/19/06 appealing from the Office action
mailed 3/29/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,683,377

MIZUTANI

11-1997

WO 98/42286 HANSER 10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani (US 5,683,377) in view of Hanser.

In regard to Claim 1 and 10, Mizutani discloses an absorbent article 1 having a topsheet 3, a backsheet 4, an absorbent core 5, longitudinal side edges 17, 18, flaps 7 having an adhesive 9 on their garment facing surface; a flap cover/barrier sheet 2/12 covers the flap adhesive and is releasable from the article (whole document). Mizutani does not expressly disclose that at least a portion of the topsheet has a skin care composition provided thereon or that the barrier sheet is treated. Hanser discloses an absorbent

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article having a topsheet, backsheet, core, longitudinal side edges, flaps having an adhesive, a flap cover, and a barrier sheet 25/125/etc (whole document). Hanser further discloses that topsheets having oil-based skin composition placed thereon reduce the adherence of body exudates to the skin of the wearer, thereby improving the ease of clean up (page 22, lines 22-27; page 20, lines 5-16; page 21, line 31-page 24, line 17). The barrier sheet may serve to protect the lotioned topsheet and may be treated with silicone and polyvinyl alcohol (PVA), which would be a selection from the group consisting of fluorochemicals, hydrophilic polymers, inorganic particles, and mixtures thereof (page 18, lines 26-page 20, line 16). One of ordinary skill in the art would have been motivated to modify the article of Mizutani by providing the topsheet with an oil-based composition and further comprising a barrier sheet treated with silicone and polyvinyl alcohol (PVA), since doing so would reduce the adherence of body exudates to the skin of the wearer and also provide releasable protection for the lotioned topsheet. Thus, it would have been obvious to one of ordinary skill in the art to modify the article of Mizutani by providing the topsheet with an oil-based composition and further comprising a barrier sheet treated with silicone and polyvinyl alcohol (PVA), which would be a selection from the group consisting of fluorochemicals, hydrophilic polymers, inorganic particles, and mixtures thereof, as taught by Hanser, since doing so would reduce the adherence of body exudates to the skin of the wearer and also provide releasable protection for the lotioned topsheet.

(10) Response to Argument***Applicant has argued:***

a. One of ordinary skill would not seek to combine Mizutani and Hanser to solve the problem of preserving the adhesive properties of an adhesive located on the garment facing surface of the wings of an absorbent article because each reference is directed to solving problems that are unrelated, and later that there is no suggestion or motivation in the references cited or to one skilled in the art to combine the references because they are directed toward solving two distinctly different problems using two distinctly different solutions that are unrelated to one another,

b. The Office Action fails to cite and the Applicants are unaware of any disclosure in Mizutani suggesting or motivating a release sheet, like that from Mizutani, be applied to the backsheet of the absorbent article of Hanser or to the adhesive on the garment-facing surface of the wings,

c. Applicants are unable to identify any portion of Mizutani motivating, teaching, or suggesting to one skilled in the art to modify the topsheet in Mizutani in any way to achieve reduced adherence of body exudates to the skin and that Examiner's statement that motivation can be found as provided in Hanser is irrelevant to Claim 1 of the current application.

d. The Office Action has used impermissible hindsight reconstruction to combine two unrelated references.

e. Mizutani does not teach or suggest a flap adhesive cover comprising a treated barrier sheet.

f. Hanser does not teach or suggest a flap adhesive cover comprising a treated barrier sheet.

In response to Applicant's arguments:

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Mizutani and Hanser both teach sanitary napkins comprising protective coverings, as such they are at the very least in the same field of applicant's endeavor.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to provide the topsheet of Mizutani with an oil-based skin care composition (lotion) can be found explicitly found in Hanser, as provided in the Office Action. It is further noted that motivation to modify a reference is not limited to the reference itself, but may be found within another reference, or again in the general knowledge of those skilled in the art. Additionally, if Applicant further contends treating the barrier sheet of Mizutani, further Mizutani provides motivation for using the teaching of Hanser since Mizutani also explicitly discloses that the release sheet "may be made from materials conventionally

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employed for these components in the art, such as films" (column 3, lines 37-43) and Hanser teaches a release sheet comprising treated plastic film (pages 18-21).

Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Examiner is relying on Hanser only for a teaching of applying an oil-based skin care composition to the topsheet of Mizutani as well as support for using a treated release sheet. Examiner is not contending that the exact physical structures of Mizutani and Hanser be combined to arrive at the currently claimed invention.

As to arguing the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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The fact that applicant has recognized another advantage (protecting the adhesive properties from contamination by the oil-based skin care composition) which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Thus, for at least these reasons, Examiner maintains that Mizutani in view of Hanser render obvious the claimed invention.

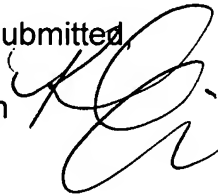
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Keshia Gibson



Conferees:

Tatyana Zalukaeva, SPE AU 3761



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